

REMARKS

Claims 51-88 and 99-109 are all the claims presently pending in the application.

Claims 1-51 and 89-98 stand canceled without prejudice or disclaimer as being directed to a non-elected invention.

While Applicant believes that all of the claims are clear and definite, and patentable over the cited references, to expedite prosecution, claims 51-61, 66-68, 70-73, 75-81, 86, and 87 have been amended to define more clearly and particularly the features of the invention, thereby overcoming the rejection under 35 U.S.C. § 112, second paragraph. New claims 99-109 are added to provide more varied protection for the features of the present invention. No new matter is added.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 51-88 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Claims 51-88 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tomat (U.S. Patent No. 6,784,925) in view of Kaibara (U.S. Patent No. 6,954,280).

This rejection is respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention, as exemplarily defined by independent claim 51, is directed to an image pick-up information transmitting system, including a communicating device capable of transmitting and receiving information to and from an image information receiver for receiving an image file, an information processing device which instructs information of directories in which function file names, which indicate at least a function for picking up an image, are registered to be transmitted to the image information receiver through the communicating device, an image pick-up device which picks up the image allocated to at least one of the function file names when the image information receiver requests an image file corresponding to the at least one of the function file names, wherein the information processing device transmits the image file obtained by picking up the image to the image information receiver through the communicating device, and wherein the communicating device is capable of transmitting and receiving the information of directories to and from the image pick-up device, a display for displaying the information of the directories which is at least one of transmitted to and received from the image pick-up device, and a selecting device which selects and designates a desired function file name of the at least one function file name showing a desired function on the basis of the displayed information of the directories.

The claimed invention, as exemplarily defined by independent claim 87, is related to a remote control method in which an information receiver selects a desired function file name on the basis of information of directories transmitted from an electronic device and receives a file of the desired function file name from the electronic device, wherein the electronic device transmits the information of the directories, which include function file names that indicate at least one function to be performed by the electronic device, to the

information receiver, the image information receiver selects the desired function file name on the basis of the transmitted information of the directories to request the electronic device to perform an operation corresponding to the desired function file name, the electronic device executes a function allocated to the desired function file name in accordance with the request and transmits a response in accordance with the execution of the function to the image information receiver, and the image information receiver receives the response.

According to the claimed invention, an image pick-up device 42 (e.g., of a digital camera 10, scanner, or the like)(*all reference numerals herein being used for the Examiner's clarity only and not for limiting the claims*) can be easily remote controlled from an image information receiver (e.g., a communication device 80).

For example, the folder list information (directory information) classified in accordance with the image pick-up conditions can be transmitted to the communication device 80 and displayed on the display 88 of the communication device 80, so that the user can rapidly select desired kinds of image pick-up or shooting conditions meeting a use and can acquire the picked up image. Further, since the communication device 80 side does not need to previously have setting information related to the parameters indicating a variety of image pick-up conditions of the image or the properties of the image, the burden of processing programs of the communication device 80 side can be advantageously reduced (e.g., see specification at page 35, lines 20-28; page 36, line 1).

Still further, since the image pick-up device 42 transmits the directory (folder) information classified for each of the parameters indicating the image pick-up conditions or the properties of the image to the communication device 80 to select and designate a desired image, the communication device 80 side is provided with only a program for

reading an ordinarily widely utilized file to select and designate a plurality of kinds of images. Further, the processing program of the communication device 80 also can merely utilize a tool high in its frequency of usage and familiar to the user, such that a comfortable operability can be obtained with little burden (e.g., see specification at page 35, lines 20-28; page 36, lines 1-10; and page 45, lines 22-23).

II. THE REJECTION UNDER 35 U.S.C. § 112

Claims 51-88 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

To expedite prosecution, claims 51-61, 66-68, 70-73, 75-81, 86, and 87 are amended to define more clearly and particularly the features of the invention, thereby overcoming this rejection.

Therefore, the Examiner is requested to reconsider and withdraw this rejection.

Applicant notes that, at page 4 of the present Office Action, the Examiner states that the claims will be interpreted to include “*an electronic camera comprising*”.

However, Applicant respectfully submits that the Examiner’s interpretation improperly reads features from the specification into the claim which are not recited in the claim.

That is, claim 51 clearly does not recite, or limit the claim to, “*an electronic camera*”, as alleged by the Examiner. Interpreting the claim as including “*an electronic camera*” clearly is improper.

For example, M.P.E.P. § 2111 clearly states that, during patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

However, it is settled law that reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. See In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

Again, claim 51 clearly does not recite, or limit the claim to, “*an electronic camera*”, as alleged by the Examiner. Indeed, it clearly is not necessary that claim 51 include “*an electronic camera*”. On the contrary, claim 51 uses the open-ended term “*comprising*”, which means the claimed device includes the explicitly recited features, but does not exclude a device which includes additional features. Therefore, it clearly is not necessary to, or proper to, read limitations from the specification into the claims, which are not recited in the claims.

Further, the specification clearly states that in the “preferred embodiment”, the image pickup device includes an electronic camera (e.g., see specification at page 11, line 26, and page 12, lines 1-5). The specification clearly does not limit the image pickup device only to an electronic camera. In fact, the specification explicitly states that:

It should be understood, however, that there is no intention to limit the invention to the specific forms disclosed, but on the contrary, the invention is to cover all modifications, alternate constructions and equivalents falling within the spirit and scope of the invention as expressed in the appended claims.

(e.g., see specification at page 48, lines 11-14; emphasis added).

Moreover, the specification clearly discloses that the invention is not limited to acquiring the image files from an electronic camera 10, but can also be applied to a personal computer or a digital audio player as well as the electronic camera 10 connected

to the communication device through the communicating device to obtain and transmit the files (e.g., see specification at page 20, lines 26-28, and page 21, lines 1-3).

Further, the specification clearly discloses that:

In the above described embodiment, although the image pick-up device according to the present invention is described as the electronic camera with the image pick-up device, it is to be understood that the present invention is not limited to the electronic camera and a scanner provided with the image pick-up device may be employed.

(see specification at page 36, lines 19-22; emphasis added).

Thus, Applicant respectfully submits that the Examiner's unnecessarily narrow interpretation of the claims as including "*an electronic camera*" is improper.

Applicant respectfully notes that the Examiner properly should consider each of the explicitly recited features of claim 51, without reading un-recited features from the specification into the claims in compliance with In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000), In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969), and M.P.E.P. § 2111.

Indeed, all of the pending claims properly should be considered based on each of the explicitly recited features of each claim, without reading un-recited features from the specification into the claims.

III. PRIOR ART REJECTION

Claims 51-88 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tomat in view of Kaibara.

The Examiner alleges that the combination of Tomat and Kaibara disclose or suggest all of the features of the claimed invention. Applicant respectfully submits,

however, that there are features of the claimed invention which are not disclosed or suggested by Tomat and Kaibara, either individually or in combination. Therefore, Applicant traverses this rejection.

Independent claims 51 and 87

With respect to independent claims 51 and 87, the Examiner acknowledges that Tomat does not disclose or suggest at least function file names, which indicate at least a function for picking up an image, that are registered in the directories and are transmitted to the image information receiver through the communicating device, or that the image pick-up device picks up the image allocated to at least one of the function file names when the image information receiver requests an image file corresponding to the at least one of the function file names, or that a selecting device selects and designates a desired function file name of the at least one function file name showing a desired function on the basis of the displayed information of the directories, as claimed.

However, the Examiner alleges that Kaibara makes up for the deficiencies of Tomat by allegedly disclosing the “transfer.img” function file, which allegedly represents a program for selecting and transmitting an image that is stored in the directory. The Examiner considers the “transfer.img” function file to be a “function file” for picking-up an image, since it allegedly is inherent to transferring an image that the image must have been previously picked up.

Applicant respectfully disagrees, and therefore, traverses this rejection.

As the Examiner points out, Kaibara discloses a file (Transfer.img) representing a program for selecting and transmitting an image. The Transfer.img file is stored in a directory (e.g., see Kaibara at column 8, lines 60-62).

However, turning to column 9, line 11, to column 10, line 37, Kaibara discloses the operation of the image sensing apparatus 100, including the execution of the Transfer expansion program (Transfer.img).

Contrary to the claimed invention, selecting the Transfer.img file does not select the desired image or cause the image pick-up device to pick up an image.

Instead, selecting the Transfer.img merely executes the Transfer program, in which an initial window for Transfer processing, such as a UI window 701 shown in FIG. 7 or a UI window 801 shown in FIG. 8 appears. Kaibara discloses that, if a log file is present, a [Check Log] button is displayed, as shown in the UI window 801 of FIG. 8. When no log file to be confirmed is present because neither transmission nor printing has been performed, or log files have been deleted, the [Check Log] button is not displayed, as shown in the UI window 701 of FIG. 7. A title representing the current layer is displayed at the upper portion of the window.

Kaibara further discloses, with reference to Figures 5, 6, and 7, the step-by-step process by which the user then selects images for sending and executes transmission of the images.

For example, Figure 7 shows a transition of the UI window 701 in selecting an image to be transmitted, wherein when the [Send] button is selected, and the [SET] button is pressed, the window changes to a window representing a menu associated with transmission, as shown in a UI window 702 (step S17). When [Select Images] is selected from this menu, and the [SET] button is pressed, images to be transmitted can be selected/canceled in the multi-displayed images, as shown in a UI window 703. The images displayed at this time are reduced thumbnail images. Kaibara further discloses that, in the first embodiment, a selected image has a check mark at its upper left portion.

In the UI window 703, the left image on the upper side and the central image on the lower side have check marks at their upper left portions. Kaibara states that these images have already been selected.

Kaibara further discloses how the execution of the transmission of the image is performed (e.g., see Kaibara at column 12, lines 9-18) and how a log file is generated after transmission (e.g., see Kaibara at column 12, lines 19-31).

In comparison, independent claim 51 recites, *inter alia*, “a selecting device which selects and designates a desired function file name of the at least one function file name showing a desired function on the basis of the displayed information of the directories” and that the “image pick-up device which picks up the image allocated to at least one of the function file names when the image information receiver requests an image file corresponding to said at least one of the function file names” (emphasis added).

Somewhat similarly, independent claim 87 recites, *inter alia*,

the electronic device transmits the information of the directories, which include function file names that indicate at least one function to be performed by the electronic device, to the information receiver;

the image information receiver selects the desired function file name on the basis of the transmitted information of the directories to request the electronic device to perform an operation corresponding to the desired function file name;

the electronic device executes a function allocated to the desired function file name in accordance with the request and transmits a response in accordance with the execution of the function to the image information receiver (emphasis added).

That is, according to the claimed invention, the selecting of the function file name instructs the image pick-up device to pick up the image that is allocated to the function file name. Thus, according to the claimed invention, an image pick-up device 42 (e.g., of a digital camera 10, scanner, or the like)(*all reference numerals herein being used for the*

Examiner's clarity only and not for limiting the claims) can be easily remote controlled from an image information receiver (e.g., a communication device 80).

For example, the folder list information (directory information) classified in accordance with the image pick-up conditions can be transmitted to the communication device 80 and displayed on the display 88 of the communication device 80, so that the user can rapidly select desired kinds of image pick-up or shooting conditions meeting a use and can acquire the picked up image. Further, since the communication device 80 side does not need to previously have setting information related to the parameters indicating a variety of image pick-up conditions of the image or the properties of the image, the burden of processing programs of the communication device 80 side can be advantageously reduced (e.g., see specification at page 35, lines 20-28; page 36, line 1).

Still further, since the image pick-up device 42 transmits the directory (folder) information classified for each of the parameters indicating the image pick-up conditions or the properties of the image to the communication device 80 to select and designate a desired image, the communication device 80 side is provided with only a program for reading an ordinarily widely utilized file to select and designate a plurality of kinds of images. Further, the processing program of the communication device 80 also can merely utilize a tool high in its frequency of usage and familiar to the user, such that a comfortable operability can be obtained with little burden (e.g., see specification at page 35, lines 20-28; page 36, lines 1-10; and page 45, lines 22-23).

In comparison, the selecting of the Transfer.img file does not select the desired image or cause the image pick-up device to pick up an image. Indeed, an image is not even allocated to the Transfer.img file.

Instead, the step of selecting the Transfer.img file merely executes the Transfer program, in which an initial window for Transfer processing appears. According to Kaibara, numerous additional selections must be made to determine which image to be transmitted, and the functions to be formed.

Hence, the step of selecting the Transfer.img file does not instruct the image pick-up device to pick up an image that is allocated to the Transfer.img file. Indeed, the images to be transferred are not allocated to the Transfer.img file. Instead, the program must be executed and then the user must later select an image to be transferred.

Thus, Kaibara does not disclose or suggest at least “*a selecting device which selects and designates a desired function file name of the at least one function file name showing a desired function on the basis of the displayed information of the directories*” and that the “*image pick-up device which picks up the image allocated to at least one of the function file names when the image information receiver requests an image file corresponding to said at least one of the function file names*”, as recited independent claim 51 (emphasis added).

Moreover, Kaibara does not disclose or suggest at least that “*the image information receiver selects the desired function file name on the basis of the transmitted information of the directories to request the electronic device to perform an operation corresponding to the desired function file name; the electronic device executes a function allocated to the desired function file name in accordance with the request and transmits a response in accordance with the execution of the function to the image information receiver*”, as recited independent claim 87 (emphasis added).

For the foregoing reasons, Tomat and Kaibara, either individually or in combination, do not disclose or suggest all of the features of the claimed invention.

Therefore, the Examiner is requested to reconsider and withdraw this rejection and to permit claims 51 and 87 to pass to immediate allowance.

DEPENDENT CLAIMS 52-86 AND 88

In the present Office Action, the Examiner groups all of dependent claims 52-86 and 88 together. The Examiner rejects claims 52-86 and 88 by asserting only that Kaibara discloses, in column 14, lines 31-49:

a response ("Receive.mrk") transmitted by the electronic device is a file with a description indicating the result of the operation (Kaibara states, "automatically generates a mark file ... for reception confirmation")

(see Office Action at page 9, numbered paragraph 7).

However, Applicant respectfully submits that the present rejection clearly fails to establish a *prima facie* case of obviousness with respect to all of the dependent claims.

Indeed, the support provided by the Examiner is directed only to a file with a description. However, some of the dependent claims have nothing to do with the file name or description. Thus, the rejection of these claims clearly is not supported by the Examiner's statement, and the Examiner's burden of establishing a *prima facie* case has not been met.

For example, the Examiner has not identified how the cited references disclose or suggest that "*the information processing device registers expected file sizes after the image is picked-up on the basis of the parameters indicating the image pick-up conditions and the properties of the image as well as the file names*", as recited, for example, in claims 57 and .

Moreover, the Examiner has not identified how the cited references disclose or suggest that "*the image information receiver calculates an expected communication time*

required for acquiring the file on the basis of the file size and does not acquire the image when the expected communication time thus calculated is larger than a predetermined communication time threshold value", as recited, for example, in claims 58, 60, 78, 80.

The Examiner also has not identified how the cited references disclose or suggest at least "*a power conservation mode setting device which sets a power conservation mode for decreasing the power consumption of the device and canceling the power conservation mode when the communicating device receives the information from the image information receiver upon setting the power conservation mode*", as recited, for example, in claims 66 and 86 (emphasis added).

The Examiner also has not identified how the cited references disclose or suggest at least "*a converted image generating device which generates a converted image in which the parameters showing the properties of the image are changed relative to an image obtained by a picking up operation as required, wherein the information processing device transmits the converted image thus generated to the image information receiver*", as recited in claim 69 (emphasis added).

Further, the present rejection fails to include a statement of the motivation for making such a combination. Thus, as matter of law, the rejection of dependent claims 52-86 and 88 fails to establish a *prima facie* case of obviousness.

Since the present rejection of claims 52-86 and 88 clearly does not establish a *prima facie* case of obviousness with respect to all of the dependent claims, the Examiner is requested to provide a new, non-final rejection which properly examines each of the features of the dependent claims.

For the foregoing reasons, Tomat and Kaibara, either individually or in combination, do not disclose or suggest all of the features of the claimed invention.

Therefore, the Examiner is requested to reconsider and withdraw this rejection and to permit claims 51-88 to pass to immediate allowance.

IV. NEW CLAIMS

New claims 99-109 are added to provide more varied protection for the present invention, as exemplarily described in the original specification and Figures of the present application.

Applicants submit that claims 99-109 are patentable over the prior art of record for somewhat similar reasons as those set forth above with respect to claims 51-88, as well as for the additional combination of features recited therein.

For example, the prior art of record does not disclose or suggest, and indeed, the Office Action does not provide any support for “*a converted image generating device that generates a converted image of the image allocated to the at least one of the function file names based on at least one of a parameter indicating an image pick-up condition and a parameter indicating a property of the image, wherein the information processing device transmits a converted image file, which includes the converted image, to the image information receiver through the communicating device*” as recited, for example, in new claim 99.

It is noted that previously presented claim 69 recites somewhat similar features as new claim 99.

Moreover, the prior art of record does not disclose or suggest, and indeed, the Office Action does not provide any support for the teaching of “the parameter indicating the image pick-up condition includes at least one of an exposure condition, a flash light emitting condition, a white balance condition, a focus condition and a zoom condition,

and wherein the parameter indicating the property of the image include at least one of a number of pixels, a compressibility, a sampling method and color information", as recited, for example, in new claim 100.

It is noted that previously presented claims 68 and 70 recite somewhat similar features as new claim 100.

Thus, Applicants submit that claims 99-109 are patentable over the prior art of record for somewhat similar reasons as those set forth above with respect to claims 51-88, as well as for the additional combination of features recited therein.

Therefore, the Examiner is requested to permit claims 99-109 to pass to immediate allowance.

V. FORMAL MATTERS

Minor editorial errors have been corrected in the specification.

Applicant gratefully acknowledges that the Examiner considered and initialed each of the references cited in the Information Disclosure Statement filed on July 17, 2006.

However, Applicant respectfully reiterates that the Examiner has not yet provided a signed and initialed form PTO 1449 for the Information Disclosure Statement filed on April 17, 2001, which cited two (2) Japanese applications (JP 5-219422 and JP 9-261619). However, the Information Disclosure Statement filed on April 17, 2001, fully complied with M.P.E.P. § 609 and 37 C.F.R. §§ 1.97-1.99.

Hence, the Examiner is requested to consider and initial all of the references cited on the PTO-1449 Form for the Information Disclosure Statements filed on April 17,

2001. For the Examiner's convenience, a copy of the PTO-1449 Form is resubmitted herewith.

VI. CONCLUSION


In view of the foregoing, Applicant submits that claims 51-88 and 99-109, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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